

Claim 25 recites, "at least one venting aperture located in a sidewall of said goggle body, said venting aperture communicating through said goggle body with said eye cavity; and exterior surface dimensional means to direct airflow thereover to create negative air pressure immediately adjacent to said venting aperture, whereby air entering said eye cavity is pulled from said eye cavity by said negative air pressure adjacent to said venting aperture."

The Examiner states the at least one venting aperture is aperture 34 in the Tackles et al. patent. The Examiner further states that Figures 1-4 show the curved means 24 through side, front, and top views, with the curved means 24 inherently diverting airflow thereover. However, there is nothing in the Office Action that provides a basis in fact or technical reasoning that suggests why Tackles creates "negative air pressure immediately adjacent to said venting aperture, whereby air entering said eye cavity is pulled from said eye cavity by said negative air pressure adjacent to said venting aperture", as claimed. As such, this omission is fatal to an anticipation rejection.

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q. 2d 1955, 1957 (Fed. Cir. 1993).

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in a thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q. 2d 1949, 1950-51 (Fed. Cir. 1999).

"In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent

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characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q. 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990); M.P.E.P. § 2112.IV., p. 2100-57, Rev. 3, August 2005.

There is nothing in the Office Action that provides a basis in fact or technical reasoning that suggests why Tackles creates "negative air pressure immediately adjacent to said venting aperture, whereby air entering said eye cavity is pulled from said eye cavity by said negative air pressure adjacent to said venting aperture", as claimed. Furthermore, at Col. 6, lines 1-7, the Tackles et al. patent teaches,

The vents 38, including the slots 39, are configured to direct air laterally and upwardly into an enclosed space defined between the inner lens 14 (FIGS. 8 and 9) and wearer's face in the as-worn condition. Advantageously, this configuration causes the circular air flow pattern indicated by the arrows in FIG. 6, before the air is exhausted through one of the membranes 34, 36.

It is submitted that the Tackles et al. patent teaches that air flow coming in from vents 38 causes a circulation pattern leading to the venting of air through openings 34, 36. It is submitted that rather than teaching pulling of air from the eye cavity via creation of negative air pressure, Tackles et al. teaches pushing of air from the eye cavity via the creation of a circulation pattern.

Therefore, because Tackles et al. fails to teach or suggest creation of negative air pressure to pull air from the eye cavity, either explicitly or inherently, Tackles et al. is not anticipatory. Therefore, the withdrawal of the rejection of Claims 25-29 and 31-34 is respectfully requested.

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CONCLUSION

In view of the foregoing remarks, applicant respectfully submits that Claims 1-34 are in condition for allowance. If the Examiner has any further questions or comments, the Examiner may contact the applicant's attorney at the number provided below.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: June 5, 2006

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